

REMARKS

By this amendment, no claims have been added, cancelled, or amended. Consequently, Claims 1-2, 4-8, 10-12, 14-18, 20-23, 25-31, and 33-38 are pending in the application.

SUMMARY OF THE OBJECTIONS/REJECTIONS

The declaration, filed March 11, 2004, to add Silvano Gai and Dinesh Dutt as inventors is allegedly defective for not meeting all criteria set forth in 37 CFR § 1.48(a)(5), namely the written consent of the assignee is missing.

The Declarations Under 37 CFR § 1.132, filed November 8, 2005, are objected to for allegedly being (a) unclear as to which person is being referred to by the pronoun “we,” (b) failing to provide insufficient evidence as to each person’s contribution.

The Declarations Under 37 CFR § 1.132 are objected to for not being timely under MPEP § 716.01(a).

Claims 1-2, 4-7, 10-12, 14-17, 202-3, 25-28, 30, 31, 33-36, and 38 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over “RSVP Receiver Proxy” by Gai et al. (“*Gai*”) in view of U.S. Patent Number 6,101,549 issued to Baugher et al. (“*Baugher*”) in view of U.S. Patent U.S. Patent Number 6,765,927 by Martin et al. (“*Martin*”) in view of U.S. Patent Application No. 2004/0022191 A1 by Bernet et al. (“*Bernet*”) in view of “Resource Reservation Protocol (RSVP) Version 1 Function Specification” by Branden et al (“*Branden*”) and in view of “RF 2748 – The COPS (Common open Policy Service) Protocol by” by Durham et al (“*Durham*”).

The rejections are respectfully traversed.

**THE DECLARATION TO ADD INVENTORS SUBMITTED HEREIN COMPLIES
WITH CFR § 1.48(a)**

The declaration, filed March 11, 2004, to add Silvano Gai and Dinesh Dutt as an inventor was alleged to be defective for not meeting all criteria set forth in 37 CFR § 1.48(a)(5), namely the written consent of the assignee is missing.

Amendment of the inventorship of an application under 37 CFR § 1.48(a) requires:

- (1) A request to correct the inventorship that sets forth the desired inventorship change;
- (2) A statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;
- (3) An oath or declaration by the actual inventor or inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43, or 1.47;
- (4) The processing fee of \$130.00 set forth in § 1.17(i); and
- (5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee.

The Applicants have determined that they inadvertently and without deceptive intent failed to name Mr. Silvano Gai and Mr. Dinesh G. Dutt as co-inventors in the application. The total number of inventors is thus four (4): Mr. Itzhak Parnafes; Mr. Shai Mohaban; Mr. Gai; and Mr. Dutt. Applicants hereby request the Office to add Mr. Gai and Mr. Dutt as named inventors. Thus, the criteria under 37 CFR § 1.48(a)(1) is satisfied.

A Statement of Inventors under 37 CFR § 1.48 executed by Mr. Gai and Mr. Dutt is filed concurrently herewith. Thus, the criteria under 37 CFR § 1.48(a)(2) is satisfied.

A Declaration executed by all four (4) inventors is filed concurrently herewith in compliance with 37 CFR § 1.48(a)(3).

The processing fee of \$130.00 set forth in § 1.17(i) in the form of a check and the written consent of the assignee under 37 CFR § 3.73 are also filed concurrently herewith in compliance with 37 CFR § 1.48(4).

Each of the four inventors has assigned his right to the invention to Cisco Technology, Inc. Executed assignments for each of the four inventors accompany this reply and are filed concurrently herewith. Thus, Cisco Technology, Inc is the sole and exclusive assignment of the present application. A Statement Under 37 CFR 3.73(b), evidencing the written consent of Cisco Technology, Inc, is filed concurrently herewith in compliance with 37 CFR § 1.48(5).

All the requirements under 37 CFR § 1.48 required to add Mr. Gai and Mr. Dutt as inventors to the present application are satisfied. Applicants respectfully request the Patent Office to confirm the foregoing change of inventors in the next Office communication.

NONOBVIOUSNESS ISSUES—GAI DOES NOT QUALIFY AS A REFERENCE

Each pending claims is rejected based, at least in part, on *Gai*. An Applicant's disclosure of his or her own work within the year before the application filing date cannot be used against the Applicant. *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982); MPEP 2132.01. A rejection based on an Applicant's own work is overcome by a declaration of the Applicant establishing that a reference is describing the Applicant's own work, even if the Applicant is not explicitly identified as a coauthor of the reference.

Attached hereto are declarations under 37 C.F.R. §1.132, signed by Shai Mohaban, Silvano Gai, and Dinish Dutt, which declare that the *Gai* reference describes the Applicants' own 50325-0085 (Seq. No.1511)

work. As Silvano Gai could not recall certain details concerning the Gai reference that occurred in 1999 in the same level of detail as Shai Mohaban and Dinesh Dutt, the facts described in the declaration under 37 C.F.R. §1.132 signed by Silvano Gai differ in level of detail, but do not contradict, the facts described in the declaration under 37 C.F.R. §1.132 signed by Shai Mohaban and Dinesh Dutt.

The declaration under 37 C.F.R. §1.132 signed by Shai Mohaban, Silvano Gai, and Dinesh Dutt clarify the contributions of (a) each of the inventors of the present application, and (b) Nitsan Elfassy and Yoram Bernet, who qualify as an author of the *Gai* reference, but did not contribute to the conception of any claim pending in the present application.

Also attached hereto is a declaration of Applicants' Attorney, Christopher J. Brokaw, attesting that Itzhak Parnafes is unavailable. Under MPEP § 715.04, if a joint inventor is deceased, refuses to sign, or is otherwise unavailable, the signatures of the remaining joint inventors are sufficient to accept a declaration under 37 C.F.R. §1.132.

Further, as explained in detail below, the declarations under 37 C.F.R. §1.132, signed by Shai Mohaban, Silvano Gai and Dinish Dutt, are timely filed.

Consequently, in view of the declarations under 37 C.F.R. §1.132, *Gai* does not qualify, and must be removed, as a reference. All of the claim rejections are based on a combination of *Gai* and other references. Without *Gai* as a base reference, the other references do not disclose, teach, or suggest the claimed combination of elements, and the references do not establish a *prima facie* case under 35 U.S.C. § 103. Accordingly, it is respectfully submitted that each of Claims 1-2, 4-8, 10-12, 14-18, 20-23, 25-31, and 33-38 are patentable over the cited art and are in condition for allowance.

THE FILING OF THE INVENTOR DECLARATIONS IS TIMELY

The Patent Office indicated in the Advisory Action of November 28, 2005 that the Applicants did not timely raise, in violation of MPEP § 714.02, the issue that the *Gai* reference describes the Applicants' own work. However, MPEP § 714.02 does not suggest a duty to raise each and every defense that may possibly be raised at the earliest possibility that the issue may be raised. Instead, MPEP § 714.02 merely stands for the proposition that the Applicants must address each issue raised in an Office Action. Applicants are entitled to use their own discretion in determining how to respond to each issue raised by an Office Action. Thus, Applicants have fully confirmed with MPEP § 714.02, as each response by the Applicants has addressed each outstanding issue raised by the Patent Office.

A declaration filed under 37 CFR § 1.132 is timely if it is submitted after final rejection, but before or on the same date of filing an appeal, upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented in compliance with 37 CFR § 1.116(e) (see MPEP § 716.01).

In the present application, Itzhak Parnafes and Shai Mohaban, two inventors of the named inventors, left the employment of the assignee shortly after the application was filed. Both Itzhak Parnafes and Shai Mohaban soon entered the employment of a competitor of the assignee. As a general rule, when an employee of one company leaves the employment of that company to join a competitor of the company, it is usually more difficult to obtain the cooperation of, or indeed make contact with, the employee than if the employee was still employed by the original company. That general rule, along with express refusals to cooperate from Itzhak Parnafes and Shai Mohaban regarding the signing of declarations for other patent applications, contributed to the Applicants' decision to respond to issues raised by Office

Actions in a manner that did not require Itzhak Parnafes and Shai Mohaban to sign a declaration in the present application.

For the first time, the Office Action of May 4, 2005 based a rejection on RFC 2748 – The COPS (Common Open Policy Service) Protocol (“the RFC 2748 reference”). In view of the RFC 2748 reference, the Applicants, for the first time, deemed it appropriate to respond to the new rejection by the submission of a signed inventor declaration from each of the inventors.

When Applicants were preparing the reply of November 4, 2005, Itzhak Parnafes and Shai Mohaban were unavailable to sign a declaration under 37 CFR § 1.132. However, in preparing the present reply, Shai Mohaban responded to a phone call by Applicants’ Attorney, Christopher J. Brokaw. Shai Mohaban indicated his willingness to assist, and eventually, over the course of multiple conversations, discussed the facts concerning the inventorship of the present application and the authorship of the *Gai* reference. To the best of Shai Mohaban’s memory, correct facts concerning the inventorship of the present application and the authorship of the *Gai* reference are presented in the declaration under 37 CFR § 1.132 that Shai Mohaban and Dinesh Dutt signed. (See paragraphs 3-5 of Silvano Gai’s Declaration.) As Silvano Gai could not remember activity in 1999 at the same level of detail as Shai Mohaban and Dinesh Dutt, the declaration under 37 CFR § 1.132 that Silvano Gai signed differs in the level of detail, but does not contradict, the declaration under 37 CFR § 1.132 that Shai Mohaban and Dinesh Dutt signed.

From the time that Mr. Brokaw became aware that the present application became abandoned upon receiving the Advisory Action mailed November 28, 2005, until today, Mr. Brokaw worked diligently with the named inventors to ascertain the information sought by the Advisory Action. However, this process took some time, as a consensus of facts needed to

be established before drafting the 37 CFR § 1.132 declarations, and establishing the consensus of facts required numerous phone calls and email exchanges between Mr. Brokaw, Shai Mohaban, Silvano Gai, and Dinesh Dutt. As the information sought by the Advisory Action mailed November 28, 2005 concerned activity that occurred in 1999, the inventors needed additional time to retrieve documentation to refresh their recollection. Further, in the period December 2005 to today, one or more inventors would often become temporarily unavailable due to vacation or a business function. In addition, during this same time period, Silvano Gai retired employment with the assignee. This also contributed to the length of time necessary to reply to the many issues raised by the Advisory Action of November 28, 2005.

All the foregoing provide good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. The executed declarations made under 37 CFR § 1.132 are timely and should be given favorable consideration.

CONCLUSION

For the reasons set forth above, it is respectfully submitted that all of the pending claims are now in condition for allowance. Therefore, the issuance of a formal Notice of Allowance is believed next in order, and that action is most earnestly solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any fee shortages or credit any overages Deposit Account No. 50-1302.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP



Christopher J. Brokaw
Reg. No. 45,620

2055 Gateway Place, Suite 550
San Jose, California 95110-1089
(408) 414-1080, ext. 225
Date: June 28, 2006
Facsimile: (408) 414-1076

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

On June 28, 2006 By Trudy Bagdon